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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/717,298	11/22/2000	Michelle Q. Wang Baldonado	1508-3180	8440
7590	08/24/2005		EXAMINER	
NIXON PEABODY LLP			SALAD, ABDULLAHI ELMU	
Clinton Square			ART UNIT	PAPER NUMBER
P.O. Box 31051				
Rochester, NY 14603			2157	

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/717,298	BALDONADO, MICHELLE Q. WANG	
	Examiner	Art Unit Salad E. Abdullahi	2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 17 May 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-29 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

Response to Amendment

1. The amendment filed on 5/17/2005 has been received and made of record.
2. Applicant's argument with respect to claims 1-29 have been fully considered but are not persuasive for the following reasons

First, applicant alleges Horibe does not discloses a message display device that non-disruptively and automatically a portion of one or more related electronic message.

Examiner, respectfully disagrees because Horibe discloses a system for simultaneously and automatically extracting and displaying a portion of one or more related electronic message. For example, when a new message is a reply message a tree of all related messages is displayed using either keyword search for related messages in the database (see col. 4, line 64 to col. 5, lines 18).

Second, examiner acknowledged dependent claims 22-29 were no addressed on the last office action dated 11/17/2004. However, since the claims are similar to the other dependent claims already rejected, this office action can't be made non-final as requested by the applicant.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 26 and 27 recites the limitation "the information storage media " in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horibe U.S. Patent No. 6,101, 532 [herein after Horibe].

As per claim 1, Horibe discloses an electronic message management system (10) comprising:

- a related message determination device (120) that determines whether one or more electronic messages are related to a new electronic message (see figs. 3a-4, col. 2, lines 40-54 and col. 4, lines 54-63 and col. 6, lines 20-49);
- a message control device (220) that assembles (merging) one or more electronic messages determined to be related to the new electronic message(see col. 3, lines 15-17, col. 5, lines 12-16 and col. 8, lines); and
- a message display device (140) that simultaneously and automatically displays a portion (title) of the one or more related electronic messages (see fig. 4 and col. 2, lines 40-54 and col. 7, lines 35-58, where when reply bottom is selected message one and related message are displayed).

Horibe is silent regarding: non-disruptively displaying the one or more related message. Nonetheless, non-disruptively displaying the one or more related message would have been an obvious modification to Horibe's system. Furthermore, Horibe teaches a related

message tree where when a first message is clicked or displayed a message tree of related messages is simultaneously displayed (see fig. 4 and col. 7, lines 44-58).

Hence, by displaying a message tree of related messages without extra steps to see the related messages one skilled in the art would have readily recognized Horibe non-disruptively displays one or more related messages. In addition, non-disruptively displaying related data would be beneficial to Horibe's system as this makes it easy for the user to quickly and efficiently display related messages. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to non-disruptively display the one or more related message, thus providing a significant advantage of automatically predicting and displaying related messages more quickly and efficiently.

As per claim 2, Horibe discloses the system of claim 1, further comprising an electronic message composition device (140) that allows a user to at least one of create or update the new electronic message (see col. 4, lines 30-42).

As per claim 3, Horibe disclose the system of claim 2, wherein the related message determination device (120) automatically determines the one or more related electronic messages after commencement of the creating or updating of the new electronic message (see col. 4, lines 54-63).

As per claim 4, Horibe discloses the system of claim 1, wherein upon selection of a portion of one of the one or more related messages, the related message is displayed (see fig. 4, and col. 7, lines 35-57).

As per claim 5, Horibe discloses the system of claim 1, wherein the related message determination is based on at least one of: a statistical analysis; a comparison of the new electronic message to at least one of the one or more related electronic messages; a keyword search (see col. 5, lines 7-11); an address field search; a recipient search; a sender search; a subject field search; a date search; and a relevancy search (see figs. 3a-4, col. 4, lines 54-63 and col. 6, lines 20-49).

As per claim 6, Horibe discloses the system of claim 1, wherein the one or more related electronic messages are at least one of: displayed in a new user interface; assembled (merged) into a digest; and stored (see col. 4, line 54 to col. 5, line 5).

As per claim 7, Horibe discloses an electronic message management method comprising:

- determining one or more related electronic messages to a new electronic message (see figs. 3A-3d and col. 7, lines 35-57);
- assembling (merging) the one or more related electronic messages (see col. 5, lines 12-16 and col. 8, lines); and

- displaying a portion of the one or more related electronic messages (see fig. 4 and col. 2, lines 40-54 and col. 7, lines 35-58, where when reply bottom is selected related messages are displayed).

Horibe is silent regarding: non-disruptively displaying the one or more related message. Nonetheless, non-disruptively displaying the one or more related message would have been an obvious modification to Horibe's system. Furthermore, Horibe teaches a related message tree where when a first message is clicked or displayed a message tree of related messages is simultaneously displayed (see fig. 4 and col. 7, lines 44-58). Hence, by displaying a message tree of related messages without extra steps to see the related messages one skilled in the art would have readily recognized Horibe non-disruptively displays one or more related messages. In addition, non-disruptively displaying related data would be beneficial to Horibe's system as this makes it easy for the user to quickly and efficiently display related messages. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to non-disruptively display the one or more related message, thus providing a significant advantage of automatically predicting and displaying related messages more quickly and efficiently.

As per claim 8, Horibe discloses the method of claim 7, further comprising creating or updating the new electronic message (see col. 4, lines 30-42).

As per claim 9, Horibe discloses the method of claim 8, wherein determining the one or more related electronic messages automatically occurs after commencement of creating or updating of the new electronic message (see figs. 3a-4, col. 4, lines 54-63 and col. 6, lines 20-49).

As per claim 10, Horibe discloses the method of claim 7, wherein upon selection of a portion of one of the one or more related messages, the related message is displayed (see fig. 4, and col. 7, lines 35-57).

As per claim 11, Horibe discloses the method of claim 7, wherein the related message determination is based on at least one of: a statistical analysis; a comparison of the new message to at least one of the one or more related electronic messages; a keyword search (see col. 5, 7-11); an address field search; a recipient search; a sender search; a subject field search; a date search; and a relevancy search (see figs. 3a-4, col. 4, lines 54-63 and col. 6, lines 20-49).

As per claim 12, Horibe discloses the method of claim 7, wherein the one or more related electronic messages are at least one of: displayed in a new user interface; assembled into a digest; and stored (see col. 4, line 54 to col. 5, line 5).

As per claims 13-18, the claims include features discussed above with respect claims 1-6, thus claims 13-18 are rejected same rational as claims 1-6.

As per claim 19, Horibe disclose an electronic message management system (10) comprising:

- a data system (100) for identifying data in electronic messages, the data system adapted to identify related electronic messages(see figs. 3A-3d and col. 7, lines 35-57);
- a message control system associated with the data system, the message control system adapted to assemble the related electronic messages(see col. 5, lines 12-16 and col. 8, lines); and
- an output device (display unit 140) adapted to communicate the related electronic messages (see col. 4, line 30-42, fig. 9, and col. 9, lines 16-39).

Horibe is silent regarding: non-disruptively displaying the one or more related message. Nonetheless, non-disruptively displaying the one or more related message would have been an obvious modification to Horibe's system. Furthermore, Horibe teaches a related message tree where when a first message is clicked or displayed a message tree of related messages is simultaneously displayed (see fig. 4 and col. 7, lines 44-58).

Hence, by displaying a message tree of related messages without extra steps to see the related messages one skilled in the art would have readily recognized Horibe non-disruptively displays one or more related messages. In addition, non-disruptively displaying related data would be beneficial to Horibe's system as this makes it easy for the user to quickly and efficiently display related messages. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to non-disruptively display the one or more related message, thus providing a significant

advantage of automatically predicting and displaying related messages more quickly and efficiently.

As per claim 20, Horibe disclose the electronic message management system of claim 19 wherein the data system further includes a rule and the data system identifies related electronic messages according to the rule (same subject matter) (see col. 5, lines 12-17).

As per claim 21, Horibe disclose the electronic message management system of claim 19 wherein the output device communicates in at least one of a human readable and computer readable format (see col. 4, line 30-42, fig. 9, and col. 9, lines 16-39).

As per claims 22, 24, 26, and 28, Horibe discloses the system of claim 1, wherein the related message determination device determines the one or more related electronic messages during a creation of the new electronic message and the message display device non-disruptively displays the portion of the one or more related electronic messages during the creation of the new electronic message (see col. 6, lines 20-49).

As per claims 23, 25, 27 and 29, Horibe discloses the system of claim 1, wherein the related message determination device determines the one or more related electronic messages to the new electronic message based on one or more rules and further comprising an interface device used to enter in the one or more rules into the related

message determination device (see figs. 3a-4, col. 4, lines 54-63 and col. 6, lines 20-49).

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Salad E. Abdullahi whose telephone number is 571-272-4009. The examiner can normally be reached on 8:30 - 5:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can

be reached on 571-272-4001. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

7. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Abdullahi salad
Primary Examiner
8/16/2005